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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,201	03/10/2005	Yoshiyuki Miyamoto	Q86719	2279
23373 7590 02/18/2009 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER				
ROLLAND, ALEX A				
ART UNIT		PAPER NUMBER		
1792				
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02/18/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/527,201

Applicant(s)

MIYAMOTO, YOSHIYUKI

Examiner

ALEX ROLLAND

Art Unit

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/26/09 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohen et al (US 5,993,697).

Cohen et al teaches a process for creating pentaheptite whereby: graphite sheets are used as a starting material (col. 11, lines 46-47); an electron beam is directed along the plane of the graphite layers (col. 11, lines 12-15); the electron beam imparts energy to carbon atom in the lattice causing the bond to rotate and convert a region of four hexagons into a region of two pentagons and two heptagons (also know

as pentaheptite) (col. 11, lines 3-6); and after rotation, the pentaheptite material was subsequently annealed (col. 7, lines 35-45).

More specifically, during the process of bond rotation, described by Cohen et al, a vacancy is formed by the electron beam for a short period of time during the rotation of the bond, the number of dangling bonds is reduced by energy provided by the electron beam forming an introducing site, the same graphite-like molecule is introduced as the bond finishes its rotation, and a new bond is generated. This is supported by the resulting structure in both cases being identical (applicant's figure 5 and figure 3 of Cohen et al).

Cohen et al also teaches that this process may be preformed on carbon nanotubes as well as combinations of nitrogen and boron atoms (col. 11, lines 34-37 and col. 10, lines 28-33).

The introducing site in the process described by Cohen et al is formed for a short period of time at a point during rotation where the carbon molecule is not bonded to the lattice. The introducing site being an 8- or 9-membered ring is believed to be inherent because the method for making and the resulting structure are the same.

The amendments filed 1/26/09 further clarify and emphasize the fact that a vacancy is formed during Applicant's process. However, vacancy formation is found to be inherent to the process described by Cohen in that a vacancy is necessary formed during bond rotation. At some point during rotation the molecule will not be bonded to the bulk structure which forms a vacancy even though the molecule remains in the plane of the bulk structure.

Response to Arguments

4. Applicant's arguments filed 1/26/09 have been fully considered but they are not persuasive. Applicant argues, in part, for the new limitation added to the claims by asserting that Cohen teaches directing the electron beam along the plane of the graphite material thus forming a periodic network of pentagons and heptagons whereas Applicant's process forms pentagons and heptagons dispersedly embedded in the hexagonal network of graphite-like material. In response, the Examiner notes that forming a periodic network is not excluded by Applicant's claims and further notes that Cohen describes such a feature at Col. 10, line 53-Col. 1, line 20. Applicant additionally argues that Cohen does not teach ejecting the molecule from the bulk of the material (destroying the material). In response, the Examiner asserts that such a feature is not a limitation found in the claims.

Conclusion

5. No Claims are allowed. All pending claims are rejected for the reasons set forth above.
6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEX ROLLAND whose telephone number is (571)270-5355. The examiner can normally be reached on Monday through Friday, 9:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Cleveland can be reached on (571)272-1418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ALEX ROLLAND/
Examiner, Art Unit 1792

/Michael Cleveland/
Supervisory Patent Examiner, Art Unit 1792